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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,201	07/11/2001	Eugene de Juan JR.	56247 (71699)	1217
21874	7590	05/14/2004	EXAMINER	
EDWARDS & ANGELL, LLP			DEMILLE, DANTON D	
P.O. BOX 55874			ART UNIT	PAPER NUMBER
BOSTON, MA 02205			3764	14

DATE MAILED: 05/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/904,201

Applicant(s)

JUAN ET AL.

Examiner

Danton DeMille

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-9 and 20 is/are allowed.
- 6) ☒ Claim(s) 10-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

Claims 10-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding the new language at the end of claims 10 and 15, “one can re-insert an injection device...” (emphasis added), this language does not positively claim the language following this phrase but rather is conditional on unknown circumstances. One can re-insert the injection device and one may not re-insert the injection device depending on certain situations. This language fails to positively require any further structural limitation that requires this function. As such the claims can be interpreted broadly to be for the situation when it is not necessary to re-insert the injection device.

Claim Rejections - 35 USC § 103

Claims 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada et al. in view of Sahatjian and optionally further in view of Krasner.

Regarding claim 10, Yamada already teaches mounting the deflated lens on the moveable member 28, moving the moveable member from a first position to a second position deploying the lens, forming the intraocular lens by injecting a medium into the lens and removing the moveable member from the eye.

Regarding the last line of the claim, the claim can be interpreted for the method where it is not necessary to re-insert the injection device to adjust the amount of optical medium and therefore Yamada comprehends the claim language.

Sahatjian teaches the conventional outer member 30 that contains and protects the inner inflatable moveable member. It would have been obvious to one of ordinary skill in the art to modify Yamada to use a separate outer tube around the inner inflatable moveable member as taught by Sahatjian to protect the human tissue and protect and guide the inflatable member to its destination.

For arguments sake, if one were to consider the last line of the claim of being able to re-insert the injection device, the self-sealing plug 16 would allow the function of re-inserting an injection device into the intraocular lens to adjust the amount of medium in the lens. Yamada has to fill the intraocular lens with fluid to create the lens and adjusting the amount is always part of the process. Even after initially injecting the lens with the fluid if upon removal of the injection device it is determined that either more fluid or less fluid is needed one can always re-insert the injection device to either inject more fluid or take fluid out. Such is well within the realm of the artisan of ordinary skill. Krasner teaches column 3, lines 15-19, the method of inserting an injection device in the lens for adjusting the amount of fluid within the lens. It would have been obvious to one of ordinary skill in the art to further modify Yamada to re-insert an injection device in the lens to adjust the fluid in the lens as taught by Krasner to modify the optical characteristics as needed.

Response to Arguments

Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

Regarding claim 10, applicant's remarks regarding Yamada not describing a self-sealing mechanism flush or continuous with the surrounding deflated lens member is not pertinent with

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regard to claim 10 because claim 10 does not require such a limitation. Therefore Yamada doesn't have to show it and the broad recitation that one can re-insert the injection device wouldn't define over Yamada. The self-sealing plug would provide that function.


Even when considering the claim language, Krasner teaches the method of adjusting the fluid level in the lens. Such is always taken into consideration when injecting the lens with the optical fluid. The amount of fluid is of prime consideration.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

ddd
12 May, 2004
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Art Unit 3764